

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

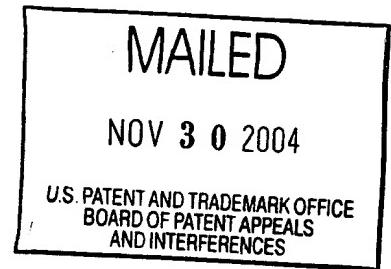
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

*Ex parte JANICE LYNN FARMER, PATSY MASK HILL, GREG P. DIETZ,
GERTRUDE COMPANION, DAVID A. COGAR, MATTHEW C. FINKELSTEIN,
EDMUND L. DICKSON, JOE WIX, and BARBARA A. STEVENS*

Appeal No. 2004-1664
Application No. 09/306,135

ON BRIEF



Before JERRY SMITH, OWENS, and NAPPI, *Administrative Patent Judges.*

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-7, 14 and 18-31, which are all of the claims pending in the application.

THE INVENTION

The appellants claim a system and method for communicating information regarding hazardous substances. Claim 24, which claims the method, is illustrative:

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24. A method for communicating hazard information, the steps comprising:

(a) entering information related to a hazardous material and its characteristics into a computerized database;

(b) selectively automatically decompiling said hazardous material into its components, and decomposition products and their respective characteristics;

(c) automatically associating said hazardous material and component characteristics with hazard information using a set of user defined hazardous material rules;

(d) recompiling said hazardous material information associated with said hazardous material and its components; and

(e) disseminating said hazardous material information related to said hazardous material and its components.

THE REFERENCE

Tipton et al. (Tipton) 6,097,995 Aug. 1, 2000
(filed Nov. 30, 1994)

THE REJECTION

Claims 1-7, 14 and 18-31 stand rejected under 35 U.S.C.
§ 102(e) as being anticipated by Tipton.

OPINION

We reverse the aforementioned rejection. We need to address only the independent claims, i.e., claims 1, 14 and 24.

"Anticipation requires that every limitation of the claim in issue be disclosed, either expressly or under principles of inherency, in a single prior art reference." *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1255-56, 9 USPQ2d 1962, 1965 (Fed. Cir. 1989).

The appellants' claim 1 requires "an automated means for selectively decompiling said hazardous material, determining its components and decomposition products and their respective characteristics." Claim 14 requires "a module for selectively decompiling said hazardous-material into its components and decomposition products and their respective characteristics." Claim 24 requires "selectively automatically decompiling said hazardous material into its components, and decomposition products and their respective characteristics."

For a disclosure of these claim requirements the examiner relies (answer, page 12) upon Tipton's column 26, lines 15-22, which discloses: "referring to window 2600 of **FIG. 26** it can be seen that the example includes 4 separate components in the chemical container. 50% of the container is acetone from

container ID No. 1099226, as shown at **2602**, 32% of the container is water as shown at **2604**, 15% is benzene from container ID 1101248 as shown at **2606**, and the remaining 3% is termed inert ingredients as shown at **2608.**"

The examiner argues that "Tipton teaches that Acetone is decomposed to determine its components: water, benzene, and termed inert ingredients and their characteristics: 32%, 15%, 3% respectively" (answer, pages 3-4), and that "[t]he cited text portion above clearly meets all requirements for the claimed element: "automated means for selectively decompiling hazardous material (i.e., 'acetone'), determining its components and decomposition products (i.e., 'water, benzene, termed inert ingredient') and their respective characteristic (i.e., 50%, 32%, 15%, 3%, respectively)" (answer, page 12).

Tipton does not disclose that water, benzene and inert ingredients are decomposition products of acetone. What Tipton discloses is a composition that contains those components. Thus, the examiner has not established that Tipton discloses decompiling a hazardous material into its decomposition products as required by the appellants' claims.

The appellants' claim 1 requires "an automated means for associating said hazardous material and said component characteristics with hazard information, using a user defined set of hazardous material rules". Claim 14 requires "a rules engine operating on a set of user-defined rules for automatically associating said hazardous material characteristics and its component characteristics with user-defined hazard information". Claim 24 requires "automatically associating said hazardous material and component characteristics with hazard information using a set of user defined hazardous material rules."

For a disclosure of user defined rules the examiner relies (answer, page 10) upon Tipton's disclosures that 1) "[t]he preferred database provides an *Ad Hoc* report feature which allows for the user to set up three pertinent elements of a report: 1) the fields to be included in the report (6702 of FIG. 67), 2) the way in which records should be sorted (6704 of FIG. 67), and 3) which records to include (6706 of FIG. 67)" (col. 41, lines 16-21), and 2) "[t]his report lists all substances in inventory showing ingredients and hazards categories of each ingredient within the chemical" (col. 41, lines 44-46).

The examiner argues that "Tipton anticipates the limitation: 'user defined set of hazardous material rule' by allowing user to define the content of the hazardous material report" (answer, page 10).

It is proper to use the appellants' specification to interpret what the appellants mean by a word or phrase in a claim. See *In re Morris*, 127 F.3d 1048, 1053-56, 44 USPQ2d 1023, 1027-30 (Fed. Cir. 1997). The appellants' specification states: "Rules are comprised of one or more rule criteria statements. Rule criteria statements are logical boolean statements (preferably, true or false)" (page 15, lines 5-6).

The examiner has not established that Tipton's selections of the fields and records to include in a report, and the order of presentation of the records, use logical boolean rule criteria statements and, therefore, are user defined rules as that term is used by the appellants.¹

¹ During patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the specification, as the claim language would have been read by one of ordinary skill in the art in view of the specification and prior art. See *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). The appellants' argument: "Tipton only provides agency and organization rules that are defined by the respective agency or organization in its disclosure of 'Information Gathering.' See Col. 54, l. 47-col. 59, l.3" (brief, page 5), is not consistent with the definition of "rules" in the appellants' specification.

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For the above reasons we find that the examiner has not carried the burden of establishing that the applied reference discloses, expressly or inherently, each element of the appellants' claimed invention. Accordingly, we reverse the examiner's rejection.

REVERSED

Jerry Smith

JERRY SMITH)
Administrative Patent Judge)

Terry J. Owens)
TERRY J. OWENS)
Administrative Patent Judge)

BOARD OF PATENT
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